

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC. and
CHOICE HOTELS INTERNATIONAL, INC.
Petitioners,

v.

FALL LINE PATENTS, LLC.
Patent Owner

Case: IPR2018-00535
Patent 9,454,748 B2

Before MICHELLE N. WORMMEESTER, SHEILA F. McSHANE, and JOHN R.
KENNY, *Administrative Patent Judges*.

**PETITIONERS' RESPONSE TO
MAY 21, 2018 ORDER BY THE BOARD**

EXHIBIT LIST

<i>Exhibit No.</i>	<i>Description</i>
1001	U.S. Patent No. 9,454,748 to Payne (“the ’748 patent”)
1002	U.S. Patent No. 6,961,586 to Barbosa et al. (“Barbosa”)
1003	U.S. Patent No. 6,202,023 to Hancock et al. (“Hancock”)
1004	U.S. Patent No. 6,332,127 to Bandera et al. (“Bandera”)
1005	Declaration of Kendyl Roman
1006	Curriculum Vitae of Kendyl Roman
1007	Excerpted portions of the ’748 patent file history
1008	Patent Owner’s Infringement Contentions Cover Document against Uber Technologies, Inc. and Choice Hotels International, Inc.
1009	Patent Owner’s Infringement Contentions Chart against Uber Technologies, Inc.
1010	Patent Owner’s Infringement Contentions Chart against Choice Hotels International, Inc.
1011	U.S. Patent 7,822,816 (“the ’816 patent”)
1012	The ’816 patent Institution Decision
1013	The ’816 patent Claim Construction Order
1014	U.S. Patent No. 6,381,535 to Durocher (“Durocher”)
1015	International Patent Application Publication No. WO 00/49530 to Parasnis (“Parasnis”)
1016	Declaration of Jonathan I. Detrixhe

I. Petitioners Relied Upon the Word Count Provided By Word

Petitioners used Word’s word-count feature to count the words in the Petition. When all of the words in Sections I and III-VIII are selected,¹ including annotated words to figures in textboxes, Word provides a count of 86 words for Section I and 13,913 words for Sections III-VIII. Ex. 1016 ¶¶ 2-6. Adding 86 to 13,913 provides a total count of 13,999—exactly the number Petitioners certified.

Petitioners provided Patent Owner a Word version of the Petition to allow it to verify the accuracy of Petitioners’ word count. Patent Owner used a different method to count the words. In particular, Patent Owner based its count on a new Word document formed by deleting everything apart from Sections I and III-VIII. *Id.* ¶¶ 7-8. Then, Patent Owner invoked Word’s word-count feature without selecting any words. Using this method, Word provides a count of 14,123. *Id.*

After investigating, Petitioners learned that Word did not count 124 words present in textbox annotations to figures, even though these textboxes were selected and Word’s count “[i]nclude[d] textboxes.” *Id.* ¶¶ 9-10. However, at the time of filing the Petition, Petitioners had no knowledge nor reason to suspect that the count provided by Word omitted these words. *Id.* ¶ 11. 37 C.F.R. § 42.24(d) (“A party may rely on the word count of the word-processing system used to prepare the paper.”); *Facebook, Inc. v. Sound View Innov., LLC*, IPR2017-01003, Paper 14

¹ Section II, mandatory notices, is exempt under 37 CFR § 42.24(a).

at 6 (P.T.A.B. Sept. 1, 2017) (“When certifying word count, a party need not go beyond the routine word count supplied by their word processing program.”).

II. The Only Images in the Petition Are Prior-Art Figures

Patent Owner also argues that text in prior-art figures should be included. Paper 6 at 43. Although “excessive cutting and pasting of **text as images**” can “circumvent[] the applicable word count rules,” Petitioners did not do that. *Google Inc. v. Makor Issues & Rights Ltd.*, IPR2016-01535, Paper 8 at 2 (P.T.A.B. Dec. 1, 2016) (emphasis added). Rather, each image in the Petition is a figure from the asserted prior art. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, IPR2016-01001, Paper 6 at 3 (P.T.A.B. Aug. 10, 2016) (“[W]e are not persuaded that the Petition's cutting-and-pasting of **drawing figures directly from exhibits** of record evidences an effort to circumvent the word count limit.”) (emphasis added).

III. Petitioners’ Proposed Remedies

The most common remedy is to increase the word count limit for Patent Owner’s Response by an equal number of words. *St. Jude Med., LLC v. Snyders Heart Valve LLC*, IPR2018-00105, Paper 12 at 5 (P.T.A.B. Apr. 3, 2018) (“[T]he appropriate remedy in our view is to increase the word count limit for Patent Owner’s Responses should trial be instituted in any of these proceedings.”); *Apotex Inc. v. Novartis AG*, IPR2017-00854, Paper 21 at 4 (P.T.A.B. Aug. 30, 2017) (same); *EMC Corp. v. Intellectual Ventures I LLC*, IPR2017-00429, Paper 11 at

28-29 (P.T.A.B. July 5, 2017) (same). In other instances, the Board has warned the violating party and ordered strict compliance with the word-count limit in the future. *Panduit Corp. v. Corning Optical Commc'ns LLC*, IPR2017-00528, Paper 7 at 20 n.3 (P.T.A.B. May 30, 2017); IPR2017-01003, Paper 14 at 6-8. Lastly, in a decision involving a repeat violator of word count limits, the Board has ordered a correction to bring the Petition into compliance. *Arctic Cat, Inc. v. Polaris Indus., Inc.*, IPR2017-00433, Paper 11 at 3 (P.T.A.B. May 31, 2017).

Patent Owner cites no decision providing the unprecedented relief of denying a Petition. To the contrary, in response to another word-count allegation brought by Patent-Owner's same counsel,² the Board recently observed that "[w]e are not aware of any Board case dismissing a petition because it exceeded the word count limit." IPR2018-00105, Paper 12 at 4, 7.

For the above reasons, Petitioners request that the Board accept the Petition and order a remedy similar to one it has imposed in the cases discussed above.

² Petitioners apologize for the "waste [of] judicial resources on this minor matter." IPR2017-00854, Paper 21 at 4 (allowing Patent Owner an additional 154 words for its Response). If Patent Owner had raised the issue with Petitioners, Petitioners would have attempted to work out an agreed remedy. *Id.* ("The parties are strongly encouraged to work these type of minor issues out among themselves").

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